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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/577,190	01/16/2007	Siegfried Thomalla	HM-726PCT	4058

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NEW YORK, NY 10017

EXAMINER

GISSEL, GUNNAR J

ART UNIT	PAPER NUMBER
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2856

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/577,190	Applicant(s) THOMALLA ET AL.	
	Examiner Gunnar J. Gissel	Art Unit 2856	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 October 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) 1 and 5 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-4, 6, 7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 April 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. Claim 6 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claim 6 recites "conducting a hydrostatic pressure test pursuant to DIN EN 10208 Part 2," which appears to be a German engineering standard, but is not described in the specification or submitted prior art. A copy of DIN EN 10208 Part 2 in English or description of all the necessary steps and equipment would enable Claim 6.
2. Claim 7 provides for the use of steel pipe in a pipeline for combustible media, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claim 7 is rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

- 3.

Claim Rejections - 35 USC § 103

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

5. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Reichl et al. (2,667,136) in view of DIN EN 10208 Part 2.

Reichl discloses a method for adjusting specific quality characteristics and/or properties of steel pipe by pressure testing, comprising the steps of pumping water into an interior of the steel pipe and pumping a predetermined additional volume of water into the steel pipe ongoing from the pressure test so that the steel pipe is loaded slightly in the plastic range.

Reichl does not explicitly disclose a pressure test pursuant to DIN EN 10208 Part 2. Reichl does not explicitly say that a predetermined second volume of fluid is put into the pipe. He does explicitly disclose a first volume of fluid (column 5, lines 4-5) and a second volume of fluid (column 5, lines 5-6) and that the pressure of the second volume may be controlled by adding additional sections to the pipe of different volumes (column 5, lines 15-30). The fact that Reichl controls pressure by changing the volume of the pipe, and expects to control the pressure reliably and with some precision indicates that the second volume of water is predetermined.

DIN EN 10208 Part 2 discloses a method pursuant to DIN EN 10208 Part 2.

It would have been obvious to one of ordinary skill in the art, at the time of the invention to use a well known engineering pressure testing standard along with a method of method of forming precision pressure bearing pipes, because it is desirable

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to sell pipes to all parties, especially parties that require pipes built to a certain specification.

Regarding Claim 2, Reichl discloses the additional water volume 11 remains in the pipe for a period of 2 to 3 min (Reichl, column 5, lines 6-7).

Regarding Claim 3, Reichl discloses the pipe is enlarged at the outer diameter by .2 to .3% (Reichl, column 1, lines 6-10). Adjusting the diameter of a pipe by a small amount, such as .2-.3% is obvious to anyone engaged in the production of precision components that must fit together.

Regarding Claim 4, Reichl discloses the additional water volume which is taken into consideration as an intended value is determined by filling in a step by step manner an additional water volume 11 into a test pipe 1 until the changes reach a previously determined limit value (Reichl, column 5, lines 39-42).

Regarding Claim 7, Reichl discloses a method of testing, enlarging and belling steel tubes. Using a steel tube as a pipeline for combustible material is so well known that virtually every combustible material has traveled through a steel tube or pipe at some point during its production, use or transport.

Response to Arguments

6. Applicant's arguments filed 10/27/2008 have been fully considered but they are not persuasive. Applicant argues that Reichl does not disclose a slight loading in the plastic range for stress testing the pipe, but what the Applicant has claimed is "the steel pipe is loaded slightly in the plastic range." As Reichl's device reshapes a steel pipe,

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the pipe must be loaded at least slightly into the plastic range, or it would not change shape.

Reichl does not explicitly say that a predetermined second volume of fluid is put into the pipe. He does explicitly disclose a first volume of fluid (column 5, lines 4-5) and a second volume of fluid (column 5, lines 5-6) and that the pressure of the second volume may be controlled by adding additional sections to the pipe of different volumes (column 5, lines 15-30). The fact that Reichl controls pressure by changing the volume of the pipe, and expects to control the pressure reliably and with some precision indicates that the second volume of water is predetermined.

Conclusion

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gunnar J. Gissel whose telephone number is (571)270-3411. The examiner can normally be reached on Mon-Fri, 7:30AM-5:00PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hezron Williams can be reached on (571)272-2208. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/GJG/

1/15/2009
/Hezron Williams/
Supervisory Patent Examiner, Art Unit 2856